

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 03,112)

In re Application of:)	
)	Examiner: Aaron Carter
DAVIDA et al.)	
)	Group Art Unit: 2624
Serial No. 09/303,053)	
)	Confirmation No. 7831
Filed: April 30, 1999)	
)	
For: SYSTEM AND METHOD FOR)	
AUTHENTICATE AND PRIVATE)	
PRESERVING BIOMETRIC)	
IDENTIFICATION SYSTEMS)	

Mail Stop: PTA
Commissioner for Patents
P. O. Box 1450
Alexandria, VA. 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER
37 CFR 1.705(b)

A request for reconsideration of the patent term adjustment indicated in the
Notice of Allowance Mailed **May 14, 2009**, is filed herewith.

A. FEE - 1.705(b)(1) – An electronic fee set forth in §1.18(e) is submitted
electronically.

B. STATEMENT OF FACTS 37 CFR 1.705(b)(2)

1. Applicant filed the patent application on April 30, 1999. **37 CFR 1.703**
date.
2. On March 24, 2003, the Applicant filed a Revocation of Prior Power of
Attorney and prosecution was taken over by the Applicant's current
Attorney.

3. **On September 12, 2003**, the Applicant filed a Response to Notice to Filing Missing Parts Mailed August 18, 2003 via United State Post Office Express Mail. The Response included two checks, one for \$375 for a CPA fee and one for \$65 for a Missing Parts Fee. **37 CFR 1.703 date.**
4. The USPTO returned a postcard to the Applicant with a date stamp of September 12, 2003.
5. The Post Office Express Mail Tracking web-site also indicated timely delivery of the Applicant's papers to the USPTO.
6. The USPTO cashed both the Applicant's checks on September 17, 2003, the USPTO received on the Applicant's Express Mail Package.
7. The USPTO mail room apparently lost the Applicant's response papers after cashing the Applicant's check and stamping a return postcard with the USPTO mail room stamp.
8. **On March 19, 2004**, the USPTO issued a Notice of Abandonment indicating the USPTO had never received any response from the Applicant even though the Applicant had received a return postcard with the USPTO mail room stamp and the USPTO had cashed the Applicant's checks. **37 CFR 1.703 date.**
9. **On June 16, 2004**, the Applicant filed a *Petition to Withdraw Holding of Abandonment* under 37 CFR 1.181(a) and a *Petition to Revive Abandoned Application* under 37 CFR 1.137(b). **37 CFR 1.703 date.**
10. The Petition was granted by the USPTO on **May 13, 2005**. **37 CFR 1.703 date.**

11. On March 29, 2006, the Applicant filed a Status Inquiry with USPTO and received no response whatsoever.
12. On October 19, 2006, the Applicant filed a Status Inquiry with the USPTO and received no response whatsoever.
13. On May 24, 2007, the Applicant filed a Status Inquiry with the USPTO and received no response whatsoever.
14. On January 9, 2008, the Applicant filed a Status Inquiry with the USPTO and received no response whatsoever.
15. On January 11, 2008, the Applicant filed a Petition Status Inquiry with the USPTO and received no response whatsoever.
16. During the time period from May 2005 until January 2008, over 2 years and 8 months the Applicant also made over twenty phone calls with no response at all from the USPTO. Nothing at all.
17. On January 11, 2008, the Applicant finally reached a clerk in Art Unit 2624 who retrieved the Applicant's file from the floor and indicated that she would have the Applicant's application put on an Examiner's docket.
18. If the Applicant had not made such diligent efforts, and had not received the help of a helpful clerk at Art Unit 2624, the Applicant's application would likely still be laying on the floor in the Petitions Division or the Art Unit.
19. On **January 22, 2008**, the Applicant filed an Information Disclosure Statement. **37 CFR 1.704(c)(3) circumstance, 37 CFR 1.703 date.**

20. Since the Applicant's application was filed in 1999, the Applicant wanted the Examiner to have all relevant information to avoid any further delay in prosecution as the USPTO, due to its own mistake, had not responded to the Applicant for over 2 years and 3 months and it had been almost 10 years since the Applicant had filed the application.
21. Up until this point, the USPTO PAIR system indicated the USPTO delay to be 1,317 days. **37 CFR 1.703 date.**
22. Filing of the IDS apparently triggered **37 CFR 1.704(c)(8)**, subtracting time from the USPTO delay to the detriment of the Applicant.
23. Time was subtracted from the USPTO delay time even though the USPTO had ignored the application for almost 3 years after granting the Petition to Withdraw Holding of Abandonment and the Applicant, even with diligent efforts could do nothing to move the application forward.
24. On January 5, 2009, almost one more year later after filing the IDS, the application was finally docketed to a patent Examiner. The actual delay from the time the USPTO incorrectly abandoned the application until it was docketed to an Examiner was 3 years and 8 months.
25. The Examiner mailed a non-final rejection on **January 9, 2009. 37 CFR 1.703 date.**
26. The Applicant filed a response on February 13, 2009, in about one month.
27. The Examiner issued a Notice of Allowance on **May 14, 2009. 37 CFR 1.703 date.**
28. The PTA listed on the Notice of Allowance was only **317** days.
29. The Applicant submits that the PTA on the Notice of Allowance is incorrect.

30. From the time the Applicant filed the IDS until the time the USPTO sent the Notice of Allowance, the USPTO calculated that the Applicant had delayed prosecution of the Application 1,526 days, even though during that time period, the Applicant did not hear a signal word from the USPTO during that time period. **37 CFR 1.704(c)(3) circumstance and 37 CFR 1.703 date.**

31. USPTO PAIR system indicates the total USPTO delay was 1,843 days, and delay due the Applicant was 1,526 days, leaving a PTA of 317 days included on the Notice of Allowance. **37 CFR 1.704(c)(3) circumstance and 37 CFR 1.703 date.**

32. The Applicant submits that the actual PTA should be 1,834 days, the calculated USPTO delay plus the incorrectly calculated Applicant's delay of 1526 days, for a total PTA of at least $(1,834 + 1,526) = 3,369$ days.

33. The Applicant requests the USPTO change the PTA on the Notice of Allowance to indicate the correct PTA of 3,369 days. **37 CFR 1.703 date.**

C. CORRECT PATENT TERM ADJUSTMENT 37 CFR 1.705(b)(2)(i)

1. Applicant submits the correct patent term adjustment should be **3,369** days.

2. See statement of facts above for relevant **37 CFR 1.703** dates indicated in bold.

D. TERMINAL DISCLAIMER 37 CFR 1.705(b)(2)(iii).

1. The patent is NOT subject to any terminal disclaimer.

E. CIRCUMSTANCES FOR FAILURE TO ENGAGE IN REASONABLE EFFORTS TO CONCLUDE PROCESSING OR EXAMINATION 37 CFR 1.705(b)(2)(iv)(A).

1. See No. 17 in the statements of facts above for **37 CFR 1.704(c)(3)** facts based on the stated rules in the CFR.


F. NO REAL CIRCUMSTANCES FOR FAILURE TO ENGAGE IN REASONABLE EFFORTS TO CONCLUDE PROCESSING OR EXAMINATION 37 CFR 1.705(b)(2)(iv)(B).

1. However, the Applicant submits that based on the unique circumstances in this matter and the fact the USPTO incorrectly abandoned the Applicant's application even though the Applicant filed a timely response, and after granting a petition to withdraw abandonment did absolutely nothing with the Applicant's application for a period of almost 3 years, the Applicant submits all of the delay is USPTO delay and none of the delay should be charged against the Applicant as the Applicant did nothing but try to expedite prosecution on an application that had been filed almost 10 years ago and ignored by the USPTO.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C.

Date: May 20, 2009

By: 
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